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10/666,173	09/19/2003	David H. Palmer	1-37091	7108
43935	7590	02/03/2006	EXAMINER	
FRASER MARTIN & MILLER LLC 132 WEST SECOND STREET PERRYSBURG, OH 43551			HURLEY, KEVIN	
		ART UNIT		PAPER NUMBER
		3611		

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**MAILED**

**FEB 03 2006**

**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/666,173

Filing Date: September 19, 2003

Appellant(s): PALMER, DAVID H.

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James Douglas Miller  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 21 November 2005 appealing from the Office action mailed 15 March 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1, 2, 4, 6, and 7 are rejected.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The brief is deficient because it indicates that claims 4 and 6 contain at least the same features and limitations as claim 1.

However, claim 4 recites the term "flange" which is broader than the term "fold" used in claim 1. Furthermore, claim 4 contains the limitation that the flange portion has an "orbicular" outer surface. This limitation is more narrow than the term "rounded" used in

claim 1. Webster's New World Dictionary defines "orbicular" as "in the form of an orb, spherical or circular". Webster's New World Dictionary defines "rounded" as "made round; flowing rather than jagged or angular." Thus rounded does not require a precise spherical or circular shape.

Claim 6 recites that the fold has a "protuberant" outer surface. This term is broader than the term "rounded" used in claim 1. Webster's New World Dictionary defines protuberant as "bulging or swelling out, protruding prominent".

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The objection to the words "rounded" and "protuberant" added to the specification as new matter, is withdrawn. The examiner agrees that the originally filed drawings support the terms "rounded" and "protuberant".

The rejection of claims 1, 2, 6, and 7 under 35 U.S.C. § 112 1<sup>st</sup> paragraph has been withdrawn. The examiner agrees that the originally filed drawings support the terms "rounded" and "protuberant".

The rejection of claims 1, 2, 4, 6 and 7 as being rejected under 35 U.S.C. 102(b) as being anticipated by Marquardt is withdrawn as Marquardt does not disclose an outwardly extending fold formed of two thicknesses of the tube.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6408672	Roe et al.	6-2002
5203194	Marquardt	4-1993

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. The amendment filed 1/18/05 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: That the reinforcement flange is “orbicular”. As noted above, Webster’s New World Dictionary defines “orbicular” as “in the form of an orb, spherical or circular”. The examiner interprets this as more narrow than “rounded” or “protuberant”. Since the drawings have not been indicated as being drawn to scale, it is not clear that the flange has an orbicular peripheral surface. The examiner would agree that the drawings support the terms “rounded” and “protuberant”.
2. Claim 4 is finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification and drawings do not support the recitation that the fold is “orbicular” The examiner interprets this as more narrow than “rounded” or “protuberant”.

Since the drawings have not been indicated as being drawn to scale, it is not clear that the flange has an orbicular peripheral surface. The examiner would agree that the drawings support the terms "rounded" and "protuberant".

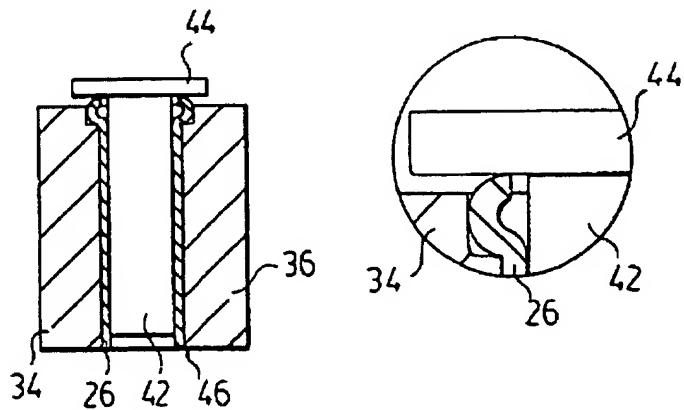
3. Claims 1, 2, 4, 6 and 7 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Roe et al.

Roe et al. discloses a receiver tube comprising:

a hollow elongate tube 26 having an internal rectangular cross-section and having a first end adapted to receive a trailer hitch bar having a complimentary outer rectangular cross-section, the first end of said tube having an integral reinforcement construction wherein the first end of said tube is provided with an outwardly extending fold 30 (col. 2 line 54 recites "the receiver tube 16 is reinforced with an end portion 30, which comprises a folded portion of the receiver tube") formed of substantially two thicknesses of the tube, wherein the outermost end portions are folded against one another to form a peripheral outwardly extending fold at the first end of said tube, the fold having an inner dimension which is substantially the same as an inner dimension of said tube and an outer dimension greater than an outer dimension of said tube, wherein the fold has a rounded outer surface (as shown in Fig. 3c, 4c below). The fold of Roe has a rounded, orbicular, and protuberant outer surface.

FIG.3c.

FIG.4c.



The patentability of a product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). It is noted that applicant has already received a patent for the process of making the device (i.e. U.S. Patent 6,796,574).

#### **(10) Response to Argument**

Regarding the objection to the amendment filed 18 January 2005 as containing new matter, applicant has argued that “the rounded outer surface is especially apparent in Fig. 3. It is indisputable, especially in view of Fig. 3, that the outer surface shown is rounded, orbicular, or protuberant”. The examiner would agree that the drawings would reasonably support that the outer surface is rounded or protuberant, however the Webster’s New World Dictionary defines “orbicular” as “in the form of an orb, spherical or circular”. The examiner interprets this as more narrow than “rounded” or “protuberant”. Since the drawings have not been indicated as being drawn to scale, it is not clear that the flange has an orbicular peripheral surface.

The arguments regarding the rejection of claim 4 as being rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, are substantially the same as those regarding the new matter objection in the previous paragraph.

Regarding the rejections of claims 1, 2, 4, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Roe et al., applicant has argued that “The outer surface of the flange is not rounded, orbicular, or protuberant to any degree, let alone to the same device as Appellant's

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structure as indicated by the Examiner. Quite simply, the tube material of Roe is compressed into the void space and takes the shape of that void space, which is rectangular in cross section with straight or linear sides". The examiner disagrees, as clearly shown in Figs 3C and 4C of Roe et al. below.

FIG. 3C.

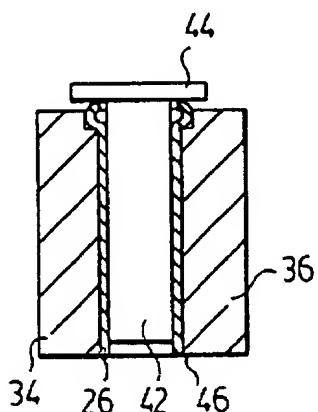
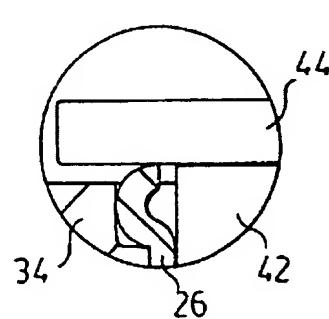


FIG. 4C.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kevin Hurley

Conferees:

Lesley Morris

Anne Marie Bohler